



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,855	07/01/2005	Minoru Yamamoto	122383	5238
25944 7590 07/29/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
MCCLEIN, GERALD				
ART UNIT		PAPER NUMBER		
3653				
MAIL DATE		DELIVERY MODE		
07/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/522,855

Applicant(s)

YAMAMOTO ET AL.

Examiner

GERALD W. MCCLAIN

Art Unit

3653

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

The amendment filed 7 May 2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In Claim 19, last line, the term "only" excludes other structures, wherein the specification clearly indicates that other structures are present at the cut in multiple locations.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 19, last line, it is unclear what structure in what location(s) is excluded by the term "only" since there is material connected to the cut portion.

Claim Rejections - 35 USC § 103

Claims 1-4, 9, 13, and 15-19, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki, et al. (US 2002/0056961 A1) ("Sasaki") in view of Fujiwara. Sasaki discloses:

Claims 1 and 16-17: package member (10); sheet package (10); printer (abstract); side part (23 and 25); edge (23 and 25; See FIG. 6 below, note that the front sections are identified in regions.); sheet storage unit (40); projecting part (55); fold-back part (11h); (Note: at *least one of the sides* of the sheets is capable of being in flush contact with the projecting member, especially as the user places the package into the storage unit.)

Claims 2 and 3: package member (10); perforated line (23 and 25, Note: 23 and 25 were are *capable of* being provided with perforated lines to cut them); side part into two parts (23 and 25);

Claim 4: projecting part (55); sheet storage unit (40); pressing member (55; Note: every action has an equal and opposite reaction. Therefore, 55 presses the stack of sheets when they press 55.);

Claim 9: projecting part (55); level difference (See FIG. 6, 50 and 52); side wall of the sheet storage unit (55 at 40); side part (23 and 25);

Claim 13: sheet package (10); single sheet-like member (paragraph [0069]);

Art Unit: 3653

Claim 15: sheet package (10); paper (paragraph [0069])

Claim 18: first part and second part (23/25);

Claim 19: perforated portion and cut portion (23/25).

Sasaki does *not directly* show the side part at a first and second position.

Fujiwara shows a similar device having the side part at a first and second position (2) for the purpose of reliably picking up sheets one at a time right up to the final sheet (paragraph [0007]). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Sasaki as taught by Fujiwara and include Fujiwara's similar device having the side part at a first and second position for the purpose of reliably picking up sheets one at a time right up to the final sheet.

Ishiduka shows a similar device having a sensor provided to the sheet storage unit, or a difference between a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line and a distance from the pressing member to a rear wall of the sheet storage unit in the sheet feed direction is smaller than a maximum permissible displacement of the mark for the sensor wherein the mark indicates the type of the stack of sheets (column 6, lines 17-32; FIG. 1 and 3A) for the purpose of allowing the printer to read the paper information from the mark (column 6, lines 22-23). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Sasaki as taught by Ishiduka and include Ishiduka's similar device having a sensor provided to the sheet storage unit, or a difference between a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line and a distance from the pressing member to a rear wall of the sheet storage unit in the sheet feed direction is smaller than a maximum permissible displacement of the mark for the sensor wherein the mark indicates the type of the stack of sheets for the purpose of allowing the printer to read the paper information from the mark.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki in view of Fujiwara and further in view of Ishiduka. Sasaki discloses all the limitations of the claims as discussed above. Sasaki does not directly show a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, or a length of the side part in the sheet feed direction after the removal of

the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction.

Ishiduka shows a similar device having a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, and a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction (column 6, lines 17-32; FIG. 1 and 3A) for the purpose of allowing the printer to read the paper information from the mark (column 6, lines 22-23). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Sasaki as taught by Ishiduka and include Ishiduka's similar device having a package member provided with a mark which can be read by a sensor provided to the sheet storage unit, and a length of the side part in the sheet feed direction after the removal of the one of the two parts at the perforated line that is substantially equal to a distance from the level difference to a rear wall of the sheet storage unit in the sheet feed direction for the purpose of allowing the printer to read the paper information from the mark.

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3653

Response to Arguments

Applicant's arguments filed 7 May 2008 have been fully considered but they are not persuasive.

Accordingly, the specification does not indicate that other structures are present at the cut in "multiple locations," because the cut merely includes a cut portion and no uncut portion, as disclosed at page 10, lines 3-10 of the specification. ...

Accordingly, claim 19 does not recite any material being connected to the cut portion as asserted on page 3 of the Office Action. Rather, the cut portion includes only a cut part (i.e. no uncut part), as clearly recited for claim 19

Material of the sheet package must be cut in order to form a cut portion. The material involved is the sheet package material at the cut. Therefore, there is not "only" the cut that is included in the cut portion.

The Office Action asserts that the push plate 11h of Sasaki corresponds to the claimed fold back part (see Office Action, page 7). However, the push plate 11h of Sasaki folds back merely to push the recording sheets 12 toward the bottom plate 11b (see Figs. 8 and 9 and paragraph [0102] of Sasaki). When the push plate 11h is folded back, the recording sheets are not exposed. (original emphasis)

In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The claimed function is to "expose part of the stack of sheets". Since fold-back part 11h "[exposes] part of the stack of sheets", the claim is rendered obvious over Sasaki in view of Fujiwara.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERALD W. MCCLAIN whose telephone number is (571)272-7803. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3653

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerald W. McClain
Examiner
Art Unit 3653

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653